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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,109	03/31/2000	Peter J. Kight	3350-31G	4187

7590

02/28/2003

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/542,109

Applicant(s)

KIGHT ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36,38-40,42-44,46-48,50-56 and 58-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36,38-40,42-44,46-48,50-56 and 58-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment C, paper number 10, received on 11/29/2002 is entered. Claims 37, 41, 45, 49, and 57 have been cancelled. Claims 36, 38-40, 42-44, 46-48, 50-56, and 58-59 are amended. New claims 60 and 61 have been added. Currently claims 36, 38-40, 42-44, 46-48, 50-56, and 58-61 are pending for examination.

Response to Arguments

2. With reference to the applicant's arguments filed on 11/29/2002 objection to claims 40, 48, and 56 is withdrawn. Applicant's arguments filed in amendment C, paper number 10, on 11/29/2002 with regards to claims 36-61 have been fully considered but are moot in view of the new ground(s) of rejection necessitated due to amendments.

This is a Final Action.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994). The applicant has claimed continuity and priority to co-pending application for U.S. Patent 09/250675, filed

February 16, 1999, which was abandoned on August 7, 2002, which was s continuation U.S. Pat. Ser. No. 08/372,620, filed January 13, 1995, which became a U.S. Pat. No 5,873,072 on February 16, 1999, which was a continuation of co-pending application for U.S. Patent. Ser. No. 07/736,071, filed on July, 25, 1991, which became a U.S. Patent No. 5,383,113 on January 17, 1995, and each having the common assignee of the present invention, see Pre-amendment # B, paper number 5, received on March 31, 2000.

With reference to the instant application, the drawings contain subject matter which was not described in the specification of the application Ser. No. 07/736,071 filed on July 25, 1991, which is now patent 5,383,113. There is also a change in the text of specification, as detailed below:

(i). FIG.1 of the patent, '113 shows flow of data to and fro between elements Consumer database, 22 and FIF File, 24 as against only unidirectional flow of data from 24, FIF File to Consumer database 22 in the patent, '113. The disclosure does not support this change that is, the reverse action from consumer database 22 editing the data in FIF 24 (see disclosure, page 5, line 16-page 6, line5). Information for FIF 24 is collected from the banking institution and the data entry in consumer database 22 is done from the information supplied by the consumer. The function of FIF 24 is to check the accuracy of the financial institution's routing number and the bank account number while entering the data supplied by the consumer and if the numbers do not correspond with the existing information in FIF 24 the data entry is rejected, corrected and repeated and the consumer database 22 is updated.

(ii). The FIG.2 of instant application, '011 shows a new interface element of interaction between elements Add a Merchant, 32 and Make Payment, 32. This element was not included in the patent, '113. Further, the disclosure does not support this new addition (see col.3, line 30-col.4, line 41). The disclosure specifies a separate process for adding merchants by a) either

consumer informs the data about merchants to service provider –which can be done by mail as being done when establishing consumer data or b) to the processor, 40 of the system (see col.3, lines 30-54). After establishing the merchant data (col.3, lines 30-54) and consumer data (col.2, line 38-col.3, line 14), payment process is initiated (see col.3, line 55-col.4, line 28).

(iii). FIG.3 of instant application, '011 includes a new element of “rejects” by processor, 40 and this “rejects” element was not included in the patent, '113. This change indicates that the processor 40 is enabled to reject instructions being received from the consumer's telecommunication device and this limitation is not supported in the disclosure. The disclosure of patent, '113 specifies that the consumer initiates the payment instructions via a telecommunication device wherein he or she accesses his merchant list, inputs the merchant payment date and amount on his/her computer screen and transmits this information to the service provider or he or she communicates the same instructions via a telephone to the service provider (see col.3, line 55-col.4, line 28, FIG.1, FIG.3). After receiving the instructions from the consumer the payment cycle is initiated separately, see FIGS. 4a, 4b, 4c, and other functions like creation of the consumer payment table 38, validation process for checking duplicate payments and sending the duplicates to a reject file (see col.4, lines 29-52, col.5, lines 42,). Moreover, col.1, line-66-col.2, line 14 describes the objectives of the invention and explicitly states that only after receiving payment instructions from the consumer they are applied, using the computer software of the present invention to examine various files to determine appropriate form of payment, validating of transactions, etc..

(iv) The disclosure of the patent, '113, discloses explicitly to use “the software of the present invention “ to compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists (see col.4, lines 38-41). However, the disclosure in the instant application does not show such explicit use of the software of the present invention “to

compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists" is absent from the instant application,'011. This implies that the applicant is broadening his scope to use the software " to compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists".

With the above changes in the drawings and in the text of the specification the instant application may constitute a continuation-in-part of the patent, '113. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

In view of the foregoing, priority cannot be allowed to the patent, '113 and instead it is restricted to the application Ser. No. 08/372,620, filed January 13, 1995. See MPEP 2163.05: Changes to the Scope of Claims: The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163 for examination guidelines pertaining to the written description requirement.

Note: Therefore, for further art rejection, priority date of January 13, 1995 will be considered.

Claim Rejections - 35 USC §101

4 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 36,38,39,40, and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The inventions as recited in the claims 36,38,39,40, and 42 are merely abstract ideas that are not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. The steps like storing, receiving, comparing, rejecting, entering, routing numbers and determining the accuracy of numbers, generating instructions may infer that these are being implemented using some type of electronic communication medium, such as a computer, network, etc. but these steps of storing, receiving, comparing, rejecting, entering, routing numbers and determining the accuracy of numbers, generating instructions could also be done manually without the use of electronic communication medium and is, therefore, directed to a non-statutory subject matter. To overcome this rejection, the Examiner recommends that the Applicant amend the claims to better clarify that the method steps of storing, receiving, comparing, rejecting, entering, routing numbers and determining the accuracy of numbers, generating instructions are done using electronic communication medium, such as a computer, network, etc.. Note: In fact, the original claims included limitations specifying the use of network before amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 36, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. (US Patent 4,321,672), hereinafter, referred to as Braun in view of Paschal, Jan, "New edition of Rand McNally Bankers directory available", Journal Record; Oklahoma City; Okla.; Feb 11, 1987, extracted on the Internet from <http://proquest.umi.com> on 01/27/2003, hereinafter, referred to as Paschal.

With regards to claims 36, and 38-39, Braun teaches a method for processing consumer banking information, comprising the steps of storing a plurality of routing numbers associated with a plurality of financial institutions, receiving and entering a routing number associated with a financial institution at which a consumer maintains a deposit account and comparing the received routing number to the stored plurality of routing numbers to verify accuracy of received routing number and if the routing number does not correspond to one of the stored plurality of routing numbers it is rejected (see at least col.11, line 50-col.12, line 8, col.1 lines 5-. Note: ABA account number includes the routing number; see FIG.7 and col.16, lines 61-66. Braun discloses receiving and entering a routing number from a negotiable unit record, and this routing number is compared with the already stored routing numbers in a data processor of a financial institution and if the received routing number does not correspond to the stored routing number it is rejected and if it matches it is accepted.).

Braun discloses that the routing numbers of the financial institutions are stored under a customer's central account in a data processor of a financial institution. Brian does not disclose that the stored plurality routing numbers of financial institutions are stored together in a designated financial institution file. However, in the same field of endeavor of storing routing numbers, Paschal teaches storing plurality of routing numbers together in a designated financial institution file (see at least Paschal, page 1, last paragraph-page 2, 2nd paragraph). Paschal teaches that Rand McNally's directory of routing numbers has been the only source for storing routing numbers together of the US banks/financial institutions since 1911. Rand McNally has been continuously publishing this directory and updating it with changes in the routing numbers of the US banks/financial institutions. In view of Paschal's teaching about Rand McNally's directory for routing numbers, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun to include Rand McNally's directory of both active and retired routing numbers to verify the accuracy of the routing number received from a customer. Doing so would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is active or retired or incorrect routing number.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braun/Paschal in view of Lawlor and further in view of Case (US Patent 4,270,042).

Braun/Paschal teaches a method for processing consumer-banking information as disclosed in claim 36 and analyzed above. Braun/Paschal further teaches bill payment via universal funds transfer instruments (see at least Braun, col.16, lines 22-26). Braun/Paschal does not teach receiving a request to pay a bill associated with a merchant on behalf of the

consumer, determining if the consumer financial institution accepts electronic fund transfer and generating an instruction to pay the bill by electronic fund transfer from the customer deposit account. However, Lawlor teaches receiving a request to pay a bill associated with a merchant on behalf of the consumer, determining if the consumer financial institution accepts electronic fund transfer and generating an instruction to pay the bill by electronic fund transfer from the customer deposit account (see at least, col.10, line 66-col.11, line 65, ".... To use bill paying features....using an ATM network, the service provider pays customer bills by first debiting the user's account.....Funds are transferred through the ATM network.....Payments are preferably processed immediately electronically, where feasible.....Otherwise bills are paid by paper check). As disclosed in col.11, lines 55-60, Lawlor determines if the payment can be done electronically and if not then it is processed via paper check. In view of Lawlor, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun/Paschal to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network and generate payment instructions via electronic funds transfer if feasible. Doing so would benefit consumers to implement bill payments electronically from home and benefit payees by cutting down their processing costs, float, offering more predictable cash flow as explicitly disclosed in Lawlor (see col.11, line 61-col.12, line 3).

Lawlor does not disclose that the feasibility of electronic funds transfer is determined based on the verified routing number. However, Case, in the field of electronic funds transfer system, teaches to determine if the consumer's financial institution accepts electronic fund transfers based on the verified routing number (see at least, FIG.3, 3A, col.4, line 61-col.5, line 2,"..a punch out element 37, which designates that the subsequent handling I to be by EFT.....The five spaces occupied by the blocks 59, 60 and the punch out 37 will be referred to

hereinafter as "ABA standards optional spaces", col.5, line 54-col.6, line 26, "... the draft, with the punch-out 37 plusmakes it possible to handle all subsequent steps in settlement of the transaction to be carried out on an EFT basis.....", col.7, lines 13-56,col.9, lines 13-34. Note: Here, Case teaches explicitly the use of an ABA space allocation 37-punch out-to denote if an electronic funds transfer is feasible or not and this ABA space location 37 corresponds to the part of routing number). In view of Case, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Braun/Paschal/Lawlor to include the feature of determining if electronic funds transfer can be made based on the verified routing numbers. Doing so would help the method of Braun/Paschal/Lawlor to determine if the payment is feasible by electronic funds transfer or via paper as suggested in both Lawlor (see at least col.11, lines 55-60) and Case (col.5, line 54-col.6, line 9).

8. Claims 42-43, 44, 46-48, 50-51, 52-56, 58-59, and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun/Paschal in view of Lawlor and further in view of Case (US Patent 4,270,042).

With regards to method claims 42-43 and 60-61 their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

With regards to system claims 44, 46-48, and 50-51, their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

With regards to article of manufacture claims 52-56, and 58-59, their limitations correspond to the limitations of method claims 36, 38-40, and are therefore analyzed and rejected using the same rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(I) US Patent 5,121,945 to Thomson et al. teaches a financial data processing system and discloses using a computer interface between the customer and financial institutions control file and a Rand McNally's financial institutional database to maintain any changes in the financial institution's information (see at least col.9, lines 40-54).

(ii) Huiyong et al., "Harcourt Brace Considers Sale Of Some Assets----Chief Says Firm Discussing Potential Transactions; Thomson May Play Role", Wall Street Journal; New York; Apr 26, 1990, extracted on the Internet from <http://proquest.umi.com> on 01/27/2003 teaches that Rand McNally's Financial Publishing division publishes directories of routing numbers under a contract with the American Bankers Association (see at least page 2, last para-page3).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
February 21, 2003


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
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